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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,059	02/17/2004	Spyridon Artavanis-Tsakonas	7326-132	8386

20583 7590 10/27/2006

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NEW YORK, NY 10017

EXAMINER

STOICA, ELLY GERALD

ART UNIT PAPER NUMBER

1647

DATE MAILED: 10/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/781,059

Applicant(s)

ARTAVANIS-TSAKONAS ET AL.

Examiner

Elly-Gerald Stoica

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-24 and 32-92 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-2,4-24,32-92 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 2, 4-24, 85 and 86 (in part), drawn to a method of detection or measuring Notch activation in a cell, classified in class 435, subclass 7.1, for example.
 - II. Claims 32-58, 79, 86 (in part) and 88 (in part) drawn to a method of identification of a Notch modulator, classified in class 435, subclass 7.21, for example.
 - III. Claims 59-67 and 86 (in part) drawn to a method of identification of a Notch modulator by detecting cleavage products, classified in class 435, subclass 3, for example.
 - IV. Claims 68-75 and 86 (in part), drawn to a method of identification of a Notch modulator by detecting cleavage products in the presence of cellular proteins, classified in class 424, subclass 1.69, for example.
 - V. Claims 76-78, 81, 87 and 89, drawn to a purified heterodimeric form of Notch, classified in class 514, subclass 2, for example.
 - VI. Claims 80, 82 and 90, drawn to a purified fragment of Notch, classified in class 530, subclass 350.
 - VII. Claims 83, 84, 91 and 92, drawn to a composition containing a specific sequence of Notch, classified in class 530, subclass 324.

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The inventions are distinct, each from the other because of the following reasons:

2. Inventions V-VII and I-IV are directed to the related Notch protein. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, each of the inventions I-IV cannot be used together with the fragments or the composition of the Inventions V-VII and they are not obvious variants.

Invention I and each of the Inventions II-IV are directed to the related Notch protein. The method of detection and measuring the Notch activation of Invention I is distinct from each of the methods of the inventions II-IV since it has a different design and mode of operation and cannot be used together and they are not obvious variants.

Invention II and each of the Inventions III-IV are directed to the related Notch protein modulators. The method of identification of a Notch modulator of Invention II is distinct from each of the methods of the inventions III-IV since it has a different design and mode of operation and cannot be used together and they are not obvious variants.

Invention III and IV are directed to the related method of identification of a Notch modulator. The method of Invention III requires a living cell while the method of Invention IV is performed with an isolated Notch protein in the presence of other cellular proteins and they are not disclosed of being capable of use together and they are not obvious variants.

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Invention VII and each of the inventions V and VI are directed to the related Notch protein. The composition of the Invention VII contains the carboxy terminus part of the Notch full length while the Invention VI is drawn to the amino terminus and the Invention V is drawn to a heterodimeric form of the notch protein. As presented the Inventions do not overlap in scope and they are not obvious variants of each other and there are not disclosed of being capable of use together.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of

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record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

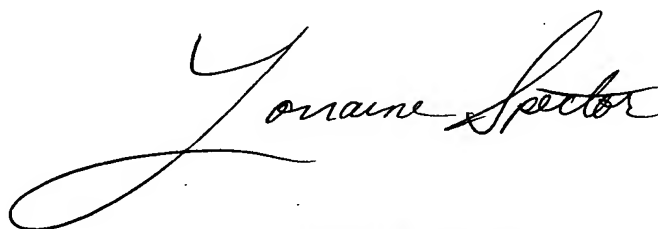
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elly-Gerald Stoica whose telephone number is (571) 272-9941. The examiner can normally be reached on 8:30-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda G. Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in cursive script, reading "Lorraine Spector". The signature is written in black ink and is positioned above the printed name and title.

LORRAINE SPECTOR
PRIMARY EXAMINER